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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/354,048	01/15/2009	Akira Saito	JP920070199US1_8150_0284	4076

52021 7590 01/22/2018

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ART UNIT	PAPER NUMBER
3692	

NOTIFICATION DATE	DELIVERY MODE
01/22/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AKIRA SAITO,
TAKEYUKI SHIMURA,
SHIGEKI TAKEUCHI,
DAISUKE TOMODA,
HAYATO UENOHARA,
and SATOSHI YOKOYAMA

Appeal 2016–001597
Application 12/354,048
Technology Center 3600

Before ANTON W. FETTING, MICHAEL C. ASTORINO, and AMEE A. SHAH, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

This is a decision on rehearing in Appeal No. 2016-001597. We have jurisdiction under 35 U.S.C. § 6(b).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision, or to responses to a new ground of rejection designated pursuant to § 41.50(b). 37 C.F.R. § 41.52.

ISSUES ON REHEARING

Appellants raise the issue of whether the claims are directed to eligible subject matter.

ANALYSIS

We entered a new ground rejecting claims 1–20 under 35 U.S.C. § 101 as directed to non–statutory subject matter. Decision 15.

We are not persuaded by Appellants' argument that the panel over-generalized what the claim is directed to. Request 2–3. Although we agree with Appellants that what a claim is directed to is distinct from what the claim involves, the intrinsic evidence indicates what the claims are directed to. We looked to intrinsic evidence in the claims and the Specification to determine that the claims are directed to payment processing. Decision 10. Most notably, the Specification at paragraph 1 recites that the invention relates to payment processing.

Appellants contend the claims are directed instead to a set of rules that allow a mobile apparatus to obtain data not typically available in a particular

context (i.e., payment selection) and to using that additional data in order to make a recommendation as to a particular electronic payment method. Request 4–5. We disagree. The use of the rules, data, and recommending are the steps to achieve a particular type of payment processing (*see* Request 4), and thus, the claims are directed to payment processing. *See Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1371–72 (Fed. Cir. 2017) (claims of paying for a subway or bus ride were directed to the abstract idea of collecting, storing, and recognizing data). Reciting details as to using rules and making a recommendation is generic advice as to functions that might achieve what the claim is directed to, but are not part of what is achieved and further, such advice is devoid of implementation details, and so remains an abstraction.

We are not persuaded by Appellants' argument that the claims do not jog memory because the data was never in the device to be jogged. Request 5. This is in the context of our having described what the claimed recitation of generating payment method candidates does. Decision 13. This description characterizes the recited list as what it really is, a series of identifiers that the user will recall when reading to provide a way to enter a selection rather than having to remember the proper data string and typing it in. It is actually irrelevant what the list is called. The point is that reciting the use of such a list is advice devoid of implementation detail.

We are not persuaded by Appellants' argument that:

> [e]lectronic payments is a technical field - arguably one of the most important technical advances that supports the modern economy. In this instance, the claimed invention is directed to addressing an issue that has arose from a particular advance in

> electronic payments systems - i.e., the ability of both merchant terminals and mobile user devices to process/use different types of electronic payments.

Request 5–6. We agree that electronic payments is a technical field. But this is no more than to say its various implementation mechanisms rely on technologies such as network communication protocols, secure communication mechanisms, and precise timing mechanisms. That a field is technical does not imbue all of its content with the aura of technology. More to the point, it does not mean that advice as to how to do something in the field suddenly becomes non-abstract implementation details. At bottom, the claims recite advice to display and use data in a manner to metaphorically represent a wallet with multiple credit cards. The recited list is a metaphoric representation of pockets of credit cards in the wallet. This is the issue Appellants point to, the ability of both merchants and users to accept and use multiple credit cards.

We are not persuaded by Appellants' argument that the Board, in citing *Elec. Power Grp. v. Alstom S.A.,* 830 F.3d 1350, 1353 (Fed. Cir. 2016), "alleges that 'claims involving data collection, analysis, and display are directed to an abstract idea.' This characterization of the holding of Electric Power Group is not accurate." Request 6. *Elec. Power* stated:

> The claims in this case fall into a familiar class of claims "directed to" a patent-ineligible concept. The focus of the asserted claims, as illustrated by claim 12 quoted above, is on collecting information, analyzing it, and displaying certain results of the collection and analysis. We need not define the outer limits of "abstract idea," or at this stage exclude the possibility that any particular inventive means are to be found somewhere in the claims, to conclude that these claims focus on

> an abstract idea—and hence require stage-two analysis under § 101.
>
> . . .
>
> Here, the claims are clearly focused on the combination of those abstract-idea processes. The advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions. They are therefore directed to an abstract idea.

Elec. Power Grp. at 1353–1354. Beyond that, what Appellants refer to as our characterization of *Electric* Power is exactly that of the Federal Circuit. *See EasyWeb Innovations, LLC v. Twitter, Inc.*, 689 Fed.Appx. 969, 971 (Fed. Cir. 2017) (non-precedential). Thus, Appellants contention that our characterization is not what the Federal Circuit meant (Request 8) is unpersuasive.

We are not persuaded by Appellants' argument that "Appellants have done more than claim the result of 'payment processing.' Rather the invention is directed to the interplay between various computer devices and use of information obtained during that interplay prior to initiation of payment processing." Request 7. First, reciting interplay and use of information as such is conceptual advice. More to the point, the claims recite only operations performed at a single terminal rather than some interplay between plural terminals, and those operations are generic computer operations devoid of implementation details that might render the otherwise abstract concepts recited more specific. *See Smart Systems*, 873 F.3d at 1374; s*ee also Versata Dev. Grp., Inc. v. SAP America, Inc.*, 793 F.3d 1306, 1334 (Fed. Cir. 2015).

CONCLUSION

Nothing in Appellants' request has convinced us that we have erred in rejecting the claims as argued by Appellant. Accordingly, we deny the request to withdraw the rejection.

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING
- We DENY the request that withdraw the new ground of rejection.

REHEARING DENIED